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WP 9  
DEB/CAE/kmb  
April 11, 2001



PATENT APPLICATION  
Attorney's Docket No.: 1818.1010-008  
(Formerly Docket No. DUK96-03pA3)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Jonathan S. Stamler and Andrew J. Gow

Application No.: 08/796,164 Group: 1627

Filed: February 6, 1997 Examiner: Celsa, B.

For: Modified Hemoglobins, Including Nitrosylhemoglobins, and Uses Therefor

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231

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Signature

Kathleen M. Bastarache

Typed or printed name of person signing certificate

SUPPLEMENTAL AMENDMENT

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

A two month extension of time to respond to the Office Action dated 12 January 2001 is respectfully requested. A Petition for Extension of Time (two months) and the appropriate fee are being filed concurrently with this Amendment. Also being filed at this time is a separate paper entitled "Supplemental Amendment and Interview Summary," which addresses issues discussed in a telephonic interview in which Applicant Jonathan S. Stamler and Attorney Carol A. Egner conferred with the Examiner.

An Amendment was previously mailed to the United States Patent and Trademark Office on October 31, 2000 with a Request for Continued Prosecution. The Amendment addressed issues in the Office Action mailed from the U.S. Patent and Trademark Office on July 31, 2000. However, the Amendment of October 31, 2000 was deemed to be not fully responsive to the Office Action because "Applicant has not responded to the double patenting rejection of the claims in item 10 of the office action mailed 7/31/00 in paper no. 31." This Supplemental Amendment now addresses item 10 of the previous Office Action of 31 July 2000. Reconsideration and further examination of the application are requested.

Issue Regarding Claims 10-22, 24-29, 40, 41, 43, 44, 46, 63, 65 and 66 (Item 10 of Office Action of July 31, 2000)

The Examiner states that the recited claims of subject Application No. 08/796,164 "conflict with claims which are present in Application No. 08/667,003 and 08/796,164." The statutory basis of the conflict is stated as being 37 C.F.R. 1.78(b), and the Examiner refers to section 822 of the M.P.E.P. The cited statute 37 C.F.R. 1.78(b) reads as follows:

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Section 822 of the M.P.E.P. is entitled "Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity," and the cited paragraph of 37 C.F.R. 1.78(b) refers to "two or more applications filed by the same applicant." Thus, the cited statute applies to comparing two applications having the same inventive entity. The subject application, U.S. Application No. 08/796,164 and its immediate parent, Application No. 08/667,003, do not have the same inventive entities. The Examiner also has not identified those claims with which Claims 10-22, 24-29, 40, 41, 43, 44, 46, 63, 65 and 66 of the subject application are said to conflict. Furthermore, in section 707.07(d) of the M.P.E.P., which addresses language to be used in rejecting claims, it is stated, "Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated, and the word



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'reject' must be used." Elsewhere in section 707.07(d) of the M.P.E.P., it is stated, "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group."

Applicants request clarification of this issue. If the Examiner sets forth double patenting rejections citing with particularity the statutory or other basis of the rejection and the claims of each application which are deemed to be drawn to inventions that are not patentably distinct, Applicants will address such rejections. Applicants have made efforts to cancel identical claims in related applications.

### CONCLUSION

The Examiner is respectfully requested to consider the above remarks made in response to Item 10 of the Office Action dated 12 January 2001, and to reconsider the application. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

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Dated: April 12, 2001